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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,660	09/06/2001	Richard B. Gayle III	P23,495 USA	2232

7590 12/13/2006

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EXAMINER

HUYNH, PHUONG N

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/807,660

Applicant(s)

GAYLE III ET AL.

Examiner

Phuong Huynh

Art Unit

1644

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 November 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires three months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: 22-25.
Claim(s) rejected: 1-3, 5, 7, 20, 21 and 26-41.
Claim(s) withdrawn from consideration: 19.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.

Continuation of 11. does NOT place the application in condition for allowance because:

Claims 1-3, 20, 26, 28, 30, 32, 34, 36, 38, and 40 stand rejected under 35 U.S.C. 112, first paragraph for new matter.

Applicants' arguments filed 11/1/06 have been fully considered but are not found persuasive.

Applicants' position is that the specific amino acids 1-15 of SEQ ID NO: 6, amino acids 25-35 of SEQ ID NO: 28, amino acids 27-34 of SEQ ID NO: 29 and amino acids 21-24 of SEQ ID NO: 30 are disclosed at pages 39 line 6, page 39, line 9, page 39, line 11 and page 40, line 13, respectively.

However, the passages pointed out by applicant still do not provide a clear support for the specified residues especially the residues are taken out of context with the reference sequences at pages 38-39.


Claims 1-3, 5, 7, 20-21, and 26-41 stand rejected under 35 U.S.C. 112, first paragraph for written description for reasons of record.

Applicants' arguments filed 11/1/06 have been fully considered but are not found persuasive.

Applicants' position is that "25-474 of SEQ ID NO: 28", "27-473 of SEQ ID NO: 29" and "21-463 of SEQ ID NO: 30" can be found at page 39, line 11, page 39, lines 16-18, and page 40, line 14-18, respectively.

However, the precised residues such as "25-474 of SEQ ID NO: 28", "27-473 of SEQ ID NO: 29" and "21-463 of SEQ ID NO: 30" are not found at page 39, line 11, page 39, lines 16-18, and page 40, line 14-18 as argued. The specification at page 39 discloses the polypeptide encoded by the Trim3 construct has the sequence SEQ ID NO:28. Residues 36-474 are a soluble portion of CD39. The polypeptide encoded by the Trim4 construct has the sequence SEQ ID NO:29. Residues 35-473 are a soluble portion of CD39, for example. All rejections remain.

Continuation of 13. Other: The replacement drawing for Fig. 4 filed on 11/1/06 is accepted by the Examiner.


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